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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,151	10/12/2000	John J. Sie	19281-000600US	8606
20350	7590	12/17/2007	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP			BROWN, RUEBEN M	
TWO EMBARCADERO CENTER			ART UNIT	PAPER NUMBER
EIGHTH FLOOR			2623	
SAN FRANCISCO, CA 94111-3834			MAIL DATE	DELIVERY MODE
			12/17/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/687,151	SIE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Reuben M. Brown	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 13 February 2006.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-13, 21, 22 and 24-30 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-13, 21-22 & 24-30 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_\_.

## **DETAILED ACTION**

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/13/2006 has been entered.

### *Response to Arguments*

2. Applicant's arguments with respect to the 103 rejection of the claims, relying singularly on Garfinkle, have been considered but are moot in view of the new ground(s) of rejection.

However, it is noted that on page 9 of the response, applicant argues that the VOD of Garfinkle is the opposite of the claimed, linearly programmed show, and thus apparently not applicable to the claims. First of all, the base reference Proehl clearly teaches at least storing short video clips that are related to linearly scheduled broadcast program(s), on a user terminal device. The difference with Proehl and the recited claims is that Proehl only discusses that the short video clips are presented when a viewer selects a broadcast program that will be broadcast in the future.

Nevertheless, one of ordinary skill in the art is presented with the disclosure of Garfinkle, which teaches pre-storing a lead-in portion of program(s), (whereas the lead-in portion of Garfinkle corresponds with the short video clips disclosed in Proehl). Thus one of ordinary skill in the art would have been motivated to combine the lead-in technique of Garfinkle, with the pre-storing of short video clips already disclosed in Proehl, at least for the benefit of allowing the customer an immediate start to a selected program, for instance, at least which overcomes a possible transmission delay that may occur, even in a scheduled broadcast.

*Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-13, 21-22 & 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Proehl, (U.S. Pat # 6,990,676), in view of Garfinkle, (U.S. Pat # 5,530,754).

Considering amended claim 1, the claimed method for receiving a program by a user location that is sent from a content distributor, comprising;

‘receiving the program at the user location as a linearly scheduled program, which can be viewed on a channel’, is met by the disclosure of Proehl that a user selects regular broadcast programming for display on the TV screen, see Abstract; Fig. 13A; Fig. 13B; col. 14, lines 26-67.

As for the claimed, ‘processing and storing a first portion of the program at the user location’, and ‘detecting a user request for the program after storage of the first portion and receiving a second portion of the program in response to the user request’, Proehl discusses that graphics images such as still shots from the instant program or short video clips related to the program, etc. may be downloaded and stored on the hard drive of the user ‘s terminal equipment, Abstract; col. 15, lines 1-18. Proehl goes on to discuss that if the user selects a linearly scheduled broadcast program that is currently being broadcast, that the system presents the user with the instant broadcast program. However, these graphics images, (such as short video clips) will be presented to the user when linearly scheduled program is selected that is scheduled to be broadcast in the future from the current date/time, which is different from the recited claims.

Nevertheless, Garfinkle provides a teaching of, receiving and storing a lead-in segment of a movie/program in the catalog store memory 22 at a user site 18; see Fig. 1; col. 1, lines 54-67 thru col. 2, lines 1-12; col. 3, lines 5-32. In particular, Garfinkle teaches that after a viewer watches previews of various movies, the instant viewer may choose product, i.e., movie/program, which is generally stored at a central site. This full-length product is then

transmitted to the viewer, col. 3, lines 10-14; col. 3, lines 65-67 thru col. 4, lines 1-12 & col. 5, lines 3-9. However, if the movie/ program that is selected by the user has a lead-in segment already downloaded to the user's site 18, then that lead-in segment is initially presented to the user, after which the remaining presentation is based on programming currently being transmitted, see col. 4, lines 19-21 & col. 4, lines 48-50. Therefore the combination of Proehl & Garfinkle meets the claimed subject matter.

The combination of Proehl & Garfinkle provides for the system to download short clips, such lead-ins for different programming services, such as linearly scheduled broadcast programs. Once a customer selects a particular broadcast program, then a lead-in segment is initially played from the user's terminal equipment, with the remaining portion coming from the regular broadcast. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Proehl with the feature of presenting the first portion of a program from downloaded segments, at least for the desirable advantage of overcoming any hiatus created by time consumed in any downloading/transmission processing, as taught by Garfinkle, col. 1, lines 61-67.

As for the amended claimed feature of: 'wherein the first portion is at least one eighth of the program", Proehl only discusses images as "short clips", without examples of the duration, whereas Garfinkle discusses that the lead-in segment may be on the order of two minutes, col. 4, lines 21-35. Official Notice is taken that at the time the invention was made, access to larger memory units/cache was well known in the art. It would have been obvious for one of ordinary

skill in the art at the time the invention was made, to modify the combination of Proehl & Garfinkle with the well-known technology of expanded memory capacity, which enables longer durations of the lead-in segments to be stored on the receiver, for example such as an hour or more, at least for the desirable improvement of expanding the time available for the system to transmit the rest of the program to the consumer.

Considering claims 2 & 11, if the viewer's home equipment has downloaded and stored a lead-in segment of the movie that the viewer has just selected, then the lead-in segment is retrieved from the catalog store 22, and begins to be displayed for the viewer; see Garfinkle, Abstract; col. 1, lines 64-67 & col. 4, lines 12-25.

Considering claims 3 & 12, the instant claims recite that a 'first time associated with playing the first portion is equal to or greater than a second time associated with receiving or transmitting a second or plurality of portions'. Accordingly, Garfinkle discloses that "the lead-in" which is stored at a user location memory 22 and played when a user selects its corresponding video product (i.e., movie), "is an initial segment of the video product sufficient in length to allow the downloading of the selected product to the user site", see col. 4, lines 19-35. Garfinkle goes on to further explain that, "For example, the lead-in segment may be of the order of two minutes long. In order to provide a seamless transition or splice from the catalog stored lead-in to the full video program stored material downloaded...".

It is noted that the claims do not recite any restrictions regarding the length of the second portion itself, specifically as compared to the first portion. Therefore Garfinkle's disclosure that the lead-in segment is of sufficient length to allow the downloading of the selected product reads on the claimed subject matter. For instance, Garfinkle discusses that if the user terminal does not have enough memory to store the entire movie, that the instant movie is transmitted in segments; col. 5, lines 14-22. The first transmission is only as much as the user terminal can store. When a certain number of minutes of the movie remain that have not been played from a particular segment, then the system transmits the next segment. Therefore the time needed to playback a downloaded portion of the movie is longer than the time for downloading the next portion of the movie.

Considering claim 4, the claimed subject matter reads on the operation of the remote controller 14 of Proehl, which used infrared technology, col. 9, lines 52-64.

Considering claims 5 & 13, the programs in Garfinkle that include a lead-in segment read on the recited programs consisting of a first and second portion; col. 4, lines 12-67. Thus, the combination of Proehl & Garfinkle meets the claimed subject matter.

Considering claim 6, the claimed set-top box reads on the integrated receiver 12 of Proehl, Fig. 1; col. 4, lines 15-67 & col. 5- col. 7.

Considering claim 7, the claimed mass storage device reads on the HDD 228 of Proehl, col. 6, lines 1-35; col. 15, lines 1-18.

Considering claim 8, the claimed feature of determining a subset of programs from a linear schedule of programs and dividing each of the subset of programs into a respective first and second respective portion reads on the server in Garfinkle periodically transmitting the lead-in segments for any group of movies, col. 2, lines 1-12; col. 4, lines 45-58. It is disclosed that lead-ins are only generated for 'certain products', which reads on 'determining a subset of programs'. The additionally claimed feature of transmitting a plurality of the respective first portions to the user location is also met by the above-cited disclosure of Garfinkle and col. 3, lines 5-17.

Considering claim 9 Garfinkle teaches that a certain of the programs at a central station 10, have lead-in segments, which in combination with Proehl, reads on the claimed 'determining a linear schedule of content programs, wherein each content comprises a first segment and a second segment'; see col. 2, lines 1-8.

The additional step of storing a second set of segments remotely from a user location reads on col. 4, lines 35-46, which discusses movies being housed in a product store 12 of the central station 10. The additionally claimed features of, 'transmitting and storing a first set of segments to the user location, and transmitting one of the second set of segments to the user location, after a request from the user' is met by col. 3, lines 1-30; col. 4, lines 12-35 & Fig. 5.

As for the amended claimed feature: 'wherein the first segment is at least fifteen minutes', represents a logical extension of the subject matter found in claim 1, and is likewise analyzed.

Considering claim 10, the claimed feature of transmitting a commercial to the user location reads on the disclosure of Garfinkle of downloading trailers or previews to the subscriber; col. 2, lines 1-6; col. 4, lines 9-12.

Considering claims 21 & 22, the claimed features correspond with subject matter mentioned above in the rejection of claims 1 & 9, and are likewise treated.

Considering claims 24 & 26, the claimed method 'wherein the first and second sets are transmitted with different media chosen from the group consisting of multicast media & singlecast media', reads on the combination of the references, since the linearly scheduled programming of Proehl meets 'multicast' and the downloaded lead-in segment of Garfinkle meets 'singlecast'.

Considering claim 25, the claimed subject matter is also met by the combination of Proehl & Garfinkle.

Considering claim 27, the claimed, 'plurality of portions' is broad enough to read on the program, in digital form, comprising a plurality of portions of a transport stream, whereas Proehl teaches that the programming may be transmitted as an MPEG video, col. 10, lines 10-18 & col. 15, lines 9-18.

Considering claim 28, the combination of Proehl & Garfinkle plays the lead-in segment, and then the remaining program, which meets the claimed subject matter.

Considering claim 29, It would have been obvious for one of ordinary skill in the art, at the time the invention was made, to operate Proehl & Garfinkle in a manner such that both of the portions of programming comes from the same channel, at least for the known advantage of avoiding the consumer, possibly having to re-tune the TV system to a different channel, in order to receive the second portion.

Considering claim 30, the claimed features correspond directly with subject matter mentioned above in the rejection of claims 1, 3, 9 & 24, and are likewise treated.

### *Conclusion*

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Art Unit: 2623

A) Hayashi Causes a beginning portion of a content to be stored and played, and a second portion to be subsequently transmitted, Abstract & Fig. 5.

B) Gudsen Teaches a local mass storage unit on a decoder box with capacity of at least 1 Gbit of data.

C) Shen Teaches transmitting and storing video programming as a plurality of discreet segments, col. 5, lines 25-55; Fig. 3.

**Any response to this action should be mailed to:**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

**or faxed to:**

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-7290 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F (9:00-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Reuben M. Brown



REUBEN M. BROWN  
PATENT EXAMINER